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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/436,076	11/08/99	WAGNER	D 10861/011003

HM12/0405  
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EXAMINER
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ART UNIT	PAPER NUMBER
1644	14

DATE MAILED:

04/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/436,076

Applicant(s)

Wagner et al.

Examiner

G. R. Ewoldt

Group Art Unit

1644



☒ Responsive to communication(s) filed on Feb 2, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

☒ Claim(s) 40-42, 45, 49-53, 56, 59, 60, and 67-72 is/are pending in the application.

Of the above, claim(s) 67-72 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 40-42, 45, 49-53, 56, 59, and 60 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 11

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

1. Claims 40-42, 45, 49-53, 56, 59-60, and 67-72 are pending.

2. Newly submitted Claims 67-72 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the invention is a patentably distinct as it is not drawn to chimeric constructs.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 67-72 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 40-42, 45, 49-53, 56, and 59-60 are being acted upon.

3. In view of Applicant's Amendment and Remarks, filed 2/02/01, only the following rejections remain.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 40-42, 45, 49-53, 56, and 59-60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention, for the reasons set forth in Paper No. 8, mailed 8/16/00.

Applicant's arguments, filed 2/02/01, have been fully considered but have not been found convincing. Applicant argues that a written description offering specific support for "chimeric constructs" can be found on pages 6 and 9 of the specification. Said pages, however, disclose no specific "chimeric constructs". In *re Ruschig*, 379 F.2d 990, 154 USPQ 118 (CCPA 1967), indicates that "[i]t is an old custom in the woods to mark trails by making blaze marks on the trees. It is of no help in finding a trail or in finding one's way through the woods where the trails have disappeared-or have not yet been made, which is more like the case here-to be confronted simply by a

large number of unmarked trees. We are looking for blaze marks which single out particular trees. We see none." "It is not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure. ... Rather, it is a question whether the application necessarily discloses that particular device." *Jepson v. Coleman*, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963). The generic disclosures found in the specification provide an insufficient written description to teach one of skill in the art how to make, and therefore, how to use, the claimed invention.

6. Claims 40-42, 45, 49-53, 56, and 59-60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the reasons set forth in Paper No. 8, mailed 8/16/00.

Applicant's arguments, filed 2/02/01, have been fully considered but have not been found convincing. Applicant argues that Example 1 provides "strong empirical evidence" that "fully supports a method for treating or preventing atherosclerosis." It is the Examiner's position that such is not the case for the reasons of record. Said "empirical evidence" is insufficient to teach one of skill in the art how to use the claimed invention without undue experimentation.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 45 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons set forth in Paper No. 8, mailed 8/16/00.

Applicant's arguments, filed 2/02/01, have been fully considered but have not been found convincing. Applicant argues that a definition for PSG1-1 can be found in a cited reference. Said definition, however, is required in the recited claims if Applicant's intent is to limit the claimed invention to the PSG1-1 of the cited reference.

9. No claim is allowed.


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday and alternate Fridays from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

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April 3, 2001

  
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